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Intellectual Property Law

F A C S I M I L E

Name: United States Patent and Trademark Office
FAX: (703) 305-0942

Today's Date: June 9, 2004
From: Eric J. Whitesell, Reg. No. 38,657 
Application No.: 09/751,609
Filing Date: December 28, 2000
Inventor: Traylor, Marc
Group Art Unit: 3632
Examiner: Szumny, Jonathon A.
Customer No. 26375
Confirmation No. 8543

Attorney Docket No.: 3066.001 73522/7335
Pages: Thirteen (13) (including this 1-page coversheet)
Dispatched by: Rhonda L. Mason

Transmitted herewith via facsimile:

Fee Transmittal (1 pg.); Reply Brief Under 37 C.F.R. § 1.193 (b)(1)
(11 pgs.); Fax Cover Sheet (1 pg.)




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(11 pgs.); Fax Cover Sheet (1 pg.)

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

Complete if Known

Application Number 09/751,609
Filing Date December 28, 2000
First Named Inventor TRAYLOR, Marc
Examiner Name Szumny, Jonathon A.
Art Unit 3632

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$55.00) Attorney Docket No. 3066.001 73522/7335

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account

Deposit Account Number 501616
Deposit Account Name Sinsheimer, Schiebelhut & Baggett

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

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FEE CALCULATION

1. BASIC FILING FEE

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|------------------------|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1001 | 770 | 2001 | 385 | Utility filing fee | |
| 1002 | 340 | 2002 | 170 | Design filing fee | |
| 1003 | 530 | 2003 | 265 | Plant filing fee | |
| 1004 | 770 | 2004 | 385 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |

SUBTOTAL (1) (\$00.00)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|--|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 | |
| 1201 | 86 | 2201 | 43 | Independent claims in excess of 3 | |
| 1203 | 290 | 2203 | 145 | Multiple dependent claim, if not paid | |
| 1204 | 86 | 2204 | 43 | **Reissue independent claims over original patent | |
| 1205 | 18 | 2205 | 9 | ** Reissue claims in excess of 20 and over original patent | |

SUBTOTAL (2) (\$00.00)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|--|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for ex parte reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | 55.00 |
| 1252 | 420 | 2252 | 210 | Extension for reply within second month | |
| 1253 | 950 | 2253 | 475 | Extension for reply within third month | |
| 1254 | 1,480 | 2254 | 740 | Extension for reply within fourth month | |
| 1255 | 2,010 | 2255 | 1,005 | Extension for reply within fifth month | |
| 1401 | 330 | 2401 | 165 | Notice of Appeal | |
| 1402 | 330 | 2402 | 165 | Filing a brief in support of an appeal | |
| 1403 | 290 | 2403 | 145 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive - unavoidable | |
| 1453 | 1,330 | 2453 | 665 | Petition to revive - unintentional | |
| 1501 | 1,330 | 2501 | 665 | Utility Issue fee (or reissue) | |
| 1502 | 480 | 2502 | 240 | Design Issue fee | |
| 1503 | 640 | 2503 | 320 | Plant Issue fee | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 | 180 | 1806 | 180 | Submission of Information Disclosure Stmt | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 770 | 2809 | 385 | Filing a submission after final rejection (37 CFR § 1.129(a)) | |
| 1810 | 770 | 2810 | 385 | For each additional invention to be examined (37 CFR § 1.129(b)) | |
| 1801 | 770 | 2801 | 385 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$55.00)

SUBMITTED BY

| Name (Print/Type) | Eric J. Whitesell | Registration No. (Attorney/Agent) | 38,657 | Telephone | 858-552-1311 |
|-------------------|---|-----------------------------------|--------------|-----------|--------------|
| Signature |  | Date | June 9, 2004 | | |

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This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 37 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450 Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: TRAYLOR, Marc
Serial No.: 09/751,609
Filed: December 28, 2000
For: RESILIENT MAGNETIC PAINT
BRUSH HOLDER
Art Unit: 3632
Examiner: Szumny, Jonathon A.

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date below.

June 9, 2004


Rhonda L. Mason

REPLY BRIEF UNDER 37 C.F.R. § 1.193(b) (1)

Mail Stop APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits this reply brief under 37 CFR § 1.193(b) (1) in response to the Examiner's Answer (Paper No. 17).

**Reply re Issue 1: the modification proposed by the
rejection lacks a reasonable expectation of success**

The Examiner's Answer errs on page 5 in interpreting the word "bendable" in column 1, lines 52-54 of Nagy as the word "resilient" recited in Claims 1, 4, 7 and 13. According to Webster's Dictionary, for example, at the Internet URL "www.merriam-webster.com", the ordinary meaning of the word "bend", as used by Nagy in the intransitive sense, is "to curve out of a straight line or position". In Nagy, the word "bendable" in column 1, lines 52-55 is used to describe the flat-faced metal strap shown in FIG. 1 that is bent into an L-shape to form the vertical leg (24). Clearly Nagy uses the word "bendable" to describe the permanent deformation of the flat-faced metal strap from a straight line into an L-shape.

On the other hand, the word "resilient" as recited in Claim 1 and used in the specification, for example, on page 7, lines 14-22, differentiates between a spring and a rigid bracket. The ordinary meaning of the word "resilient" according to Webster's Dictionary is "capable of withstanding shock without permanent deformation or rupture", which is consistent with the description of the spring in the specification.

Because the word "bendable" in Nagy clearly refers to the permanent deformation of a metal strap into an L-shape, the PTO's interpretation of the word "bendable" in Nagy contradicts the ordinary meaning of the word "resilient" recited in the claims. Because the PTO's interpretation of the word "bendable" in Nagy contradicts the ordinary meaning of the word "resilient" recited in the claims, the PTO's interpretation of the word "bendable" in Nagy and the use of that interpretation to support the rejection of Claims 1-20

are invalid.

The Examiner's Answer further errs on page 5 in alleging that Nagy inherently suggests the claimed force constant selected to produce a displacement of the distal portion of the vertical leg (24) so that the paintbrush (10) does not slide off the magnet (48) when subjected to a mechanical shock. The Examiner's Answer argues on page 6 that Nagy shows in FIG. 1 that the paintbrush (10) is attached to the magnet (48), therefore there must be some force constant selected to produce a displacement of the distal portion of the vertical leg (24) when the paintbrush (10) is subjected to a mechanical shock so that the paintbrush (10) does not slide off the magnet (48).

However, the Examiner's Answer fails to provide any support in Nagy for the gratuitous conclusion that FIG. 1 includes subjecting the paintbrush (10) to a mechanical shock, for example, caused by setting the can (6) down abruptly. Clearly the rejection relies on hindsight gleaned solely from Appellant's disclosure to arrive at the conclusion that Nagy includes subjecting the paintbrush (10) to a mechanical shock in FIG. 1. In fact, the Examiner's Answer admits on page 9 that Nagy does not even recognize the need to mechanically isolate the paintbrush (10) from the can (6). The fact that Nagy does not even recognize the need to mechanically isolate the paintbrush (10) from the can (6) argues strongly against the PTO's conclusion that Nagy includes subjecting the paintbrush (10) to a mechanical shock in FIG. 1.

As explained in the Appeal Brief, the rejection provides neither a basis in fact nor the technical reasoning to support the conclusion that the claimed force constant necessarily flows from the teachings of the applied prior art as required by MPEP § 2112 to support the PTO's allegation

that the claimed force constant is inherent in Nagy.

The Examiner's Answer further errs on page 6 in mischaracterizing Appellant's argument that the vertical orientation of the vertical leg (24) in Nagy would result in transforming most of the force between the paintbrush (10) and the can (6) into compression or tension. Appellant's argument does not require that the member (24) be perfectly vertical as implied by the Examiner's Answer. In column 2, lines 44-46, Nagy describes the member (24) as follows:

"This strap is bent upon itself between its ends as at 22 to provide an upstanding vertically disposable leg 24 and an adapter bracket 26."

According to well-known principles of mechanics, the nearly vertical orientation of the "vertically disposable leg" (24) in FIG. 1 of Nagy is sufficient to substantiate Appellant's technical reasoning that most of the force between the paintbrush (10) and the can (6), for example, when the can (6) is picked up or set down abruptly, would be transformed into compression or tension in the vertical leg (24). The resulting compression or tension in the vertical leg (24) would not result in a significant displacement of the distal portion of the vertical leg (24) to reduce acceleration of the paintbrush (10), even if the vertical leg (24) were resilient as alleged by the rejection.

Because the Examiner's Answer does not contest Appellant's position that the nearly vertical orientation of the vertical leg (24) in Nagy would result in transforming most of the force between the paintbrush (10) and the can (6) into compression or tension so that there would be no significant displacement of the distal portion of the vertical leg (24) to reduce acceleration of the paintbrush (10), the rejection fails to establish a reasonable expectation of

success in arriving at the claimed invention as required by MPEP § 2142 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Further, as explained in the Appeal Brief, Nagy teaches away from the claimed resilient member by expressing a preference, for example, in the abstract, for implementing the vertical leg (24) as a flat-faced metal strap to support the paintbrush, which typically results in the paintbrush (10) sliding off the magnet into the paint when the paintbrush (10) is subjected to a mechanical shock as explained by Appellant in the specification. Because Nagy teaches away from the claimed resilient member, the rejection fails to establish a reasonable expectation of success in arriving at the claimed invention as required by MPEP § 2142 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

The Examiner's Answer further errs on page 6 and on page 7 in denying that the rejection requires a modification of Nagy to arrive at the claimed invention and in alleging that the claimed selected force constant is inherent in Nagy. If no modification of Nagy is required to arrive at the claimed invention, then the rejection should properly be based on anticipation, not obviousness. The admission by the rejection that the specific value of the claimed force constant is not taught in Nagy does not preclude anticipation, if in fact the specific value of the claimed force constant is inherent in Nagy as alleged in the rejection. Because the rejection is not based on anticipation, however, the rejection must propose a modification of Nagy to arrive at the claimed invention and must show a motivation in Nagy for making the proposed modification to substantiate a rejection under 35 CFR § 103 according to MPEP § 2142 (2100-124). Because the PTO refuses to propose such a modification and refuses to provide

a motivation for making the proposed modification, the rejection fails to establish a reasonable expectation of success as required by MPEP § 2142. Because the rejection fails to meet the requirements of MPEP § 2142, the rejection lacks the support necessary to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Reply re Issue 2: the claimed force constant is not inherent in Nagy

The Examiner's Answer further errs in alleging on page 8 that the vertical leg (24) in Nagy is not described and shown in FIG.1 as a rigid bracket. No displacement of the distal portion of the vertical leg (24) is shown or described by Nagy that would prevent the paintbrush (10) from sliding off the magnet (48) when the paintbrush (10) is subjected to a mechanical shock. Because no displacement of the distal portion of the vertical leg (24) is shown or described in Nagy that would prevent the paintbrush (10) from slipping off the magnet (48) when the paintbrush (10) is subjected to a mechanical shock, and because Nagy does not recognize the need to mechanically isolate the paintbrush (10) from the can (6), and because the characterization of the vertical leg (24) by Nagy as "bendable" contradicts the ordinary meaning of "resilient", it is reasonable to conclude that the vertical leg (24) in Nagy is a rigid bracket.

Further, because the vertical leg (24) disclosed in Nagy is not shown or described as having a displacement of the distal portion sufficient to prevent the paintbrush from slipping off the magnet (48) when the paintbrush (10) is subjected to a mechanical shock, the claimed force constant is not shown to be inherent in Nagy as alleged in the rejection.

The rejection further fails to provide a basis in fact and the technical reasoning to support the PTO's conclusion that the claimed force constant necessarily flows from Nagy. Because the rejection fails to provide a basis in fact and the technical reasoning to support the conclusion that the claimed force constant necessarily flows from Nagy, the rejection fails to meet the requirements of MPEP § 2112 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

On the other hand, Appellant has provided both the basis in fact and the technical reasoning to support the conclusion that the claimed force constant cannot be inherent in Nagy. Specifically, the nearly vertical orientation of the vertical leg (24) as shown in FIG. 1 would result in transforming most of the force between the paintbrush (10) and the can (6) into compression or tension in the vertical leg (24) so that there would be no significant displacement of the distal portion of the vertical leg (24) to reduce acceleration of the paintbrush (10).

Because the rejection does not make clear that Nagy shows in FIG. 1 or in the accompanying description that there is a displacement of the distal portion of the vertical leg (24) when the paintbrush (10) is subjected to a mechanical shock sufficient to prevent the paintbrush (10) from sliding off the magnet (48), the rejection clearly fails to substantiate the PTO's allegation that the claimed force constant is inherent in Nagy as required by MPEP § 2142 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Reply re Issue 3: the claimed invention as a whole is not obvious over Nagy

The rejection further errs on page 9 in dismissing

the selection of the claimed resilient member, which includes the claimed force constant, as a "user preference or a design choice" without considering the claimed invention as a whole. As admitted by the Examiner's Answer on page 9, Nagy does not even recognize the need to mechanically isolate the paintbrush (10) from the can (6). Clearly there is no teaching or suggestion in Nagy that would motivate one of ordinary skill in the art to select a resilient member to provide mechanical isolation absent a recognition of the need for the mechanical isolation. Because the rejection fails to consider the invention as a whole, the rejection fails to meet the requirements of MPEP § 2141.02 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

The rejection further errs on page 2 and on page 3 of Paper No. 10 in alleging that Nagy's vertical leg (24) arrives at the claimed invention because it "inherently acts as a spring whenever a force is applied perpendicularly to it". As may readily be appreciated from FIGS. 1 and 2 in Nagy, the force applied to the vertical leg (24) when the paint can (6) is picked up and set down is substantially parallel to the vertical leg (24), not perpendicular as alleged by the rejection. The position of the Appellant that the force applied to the vertical leg (24) is substantially parallel to the vertical leg (24) when the can (6) is picked up and set down is not contested in the Examiner's Answer. As explained above, the nearly vertical orientation of the vertical leg (24) as shown in FIG. 1 would result in transforming most of the force between the paintbrush (10) and the can (6) into compression or tension in the vertical leg (24) so that there would be no significant displacement of the distal portion of the vertical leg (24) to reduce acceleration of the paintbrush (10), even if the vertical leg (24) were

resilient as alleged by the rejection. Because the rejection fails to consider the invention as a whole, the rejection fails to meet the requirements of MPEP § 2141.02 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Reply re Issue 4: the rejection fails to establish a motivation in the prior art to make the proposed modification

The Examiner's Answer insists on page 10 that no modification of *Nagy* to arrive at the claimed invention is proposed by the rejection because the claimed force constant is allegedly inherent in *Nagy*, therefore no motivation for making the proposed modification is required to support the rejection under 35 U.S.C. § 103. However, MPEP § 2142 (2100-124) states to the contrary:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Because the rejection admittedly fails to propose a

modification of Nagy to arrive at the claimed invention, and because the rejection fails to establish a motivation in Nagy for making such a modification, there is insufficient support according to MPEP § 2142 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Reply re Argument supporting separate patentability of claims on appeal

The Examiner's Answer further errs on page 10 in alleging that Nagy teaches or suggest the claimed paintbrush holder of Claim 14 wherein the resilient member, the magnet holder, and at least a portion of the clamp constitute a single molded structure. As Nagy shows in FIG. 1 and explains from column 2, line 60 to column 3, line 5, the magnet (48) is held on the upper portion of the leg (24) by a washer (40) and two rectangular cleats (42) and (44) as shown in FIG. 1. The magnet (48), the vertical leg (24), the washer (40), and the two rectangular cleats (42) and (44) are clearly shown as separate structures that are fastened, not molded, by the tang (38) located at (46) on the vertical leg (24) to hold the separate structures together. Because Nagy shows the magnet (48), the vertical leg (24), the washer (40), and the two rectangular cleats (42) and (44) as an assembly of separate structures held together by the bent tang (38), they do not constitute the claimed single molded structure as alleged in the Examiner's Answer.

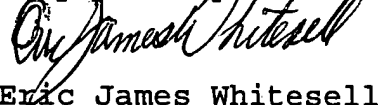
Also, Nagy teaches in column 2, lines 64-67 that the tang (38) on the upper portion of the vertical leg (24) is bent, meaning permanently deformed, to hold the plate (42) at the location (46). If the vertical leg (24) were equivalent to the claimed resilient member as alleged by the rejection,

then the tang (38) on the vertical leg (24) would return to its unbent position, releasing the magnet (48), the washer (40), and the two rectangular cleats (42) and (44) from the vertical leg (24). The fact that the tang (38) on the vertical leg (24) is bent, that is, permanently deformed, to hold the plate (42) at location (46) on the vertical leg (24) is further evidence that the vertical leg (24) cannot be resilient according to its ordinary meaning. Because the vertical leg (24) cannot be resilient, Nagy teaches away from the claimed resilient member. Because Nagy teaches away from the claimed resilient member, there is insufficient support according to MPEP § 2144.05(III) (2100-138) to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

For the reasons explained above and in the Appeal Brief, Appellant submits that the rejection of Claims 1-20 under 35 U.S.C. § 103 should be vacated.

The fee for an extension of time to June 9, 2004 is attached to this reply brief.

Respectfully submitted,


Eric James Whitesell

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